

## **REMARKS**

### **Indefiniteness rejections**

Claims 1, 4-14, 17, and 18 were rejected under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that the applicant regards as the invention. (Paper No. 10 at 2.)

In making the rejection, the Examiner asserted that “the term ‘long chain’ in claims 1-3 and 12 is relative which renders the claim indefinite.” In particular, the Examiner asserted that:

- the term was not defined in the claim,
- the specification does not provide a standard for ascertaining the requisite degree, and
- one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

The Examiner concluded that “[t]he claim is indefinite as to the chain length of the alcohol.”

The Examiner apparently took issue with “the definition of the phrase” long chain. (Paper No. 10 at 4.) The Examiner asserted that “one of ordinary skill in the art would not be “reasonably” apprised of the scope of the invention” because of the alleged ambiguity of the phrase “long chain.” In particular, the Examiner appeared to emphasize that it is the chain length of the alcohol that rendered the claim indefinite.

For the reasons set forth below, the rejection is traversed

The Examiner is directed to page 3, lines 4-14 of the instant specification wherein it is expressly disclosed what is meant by “long chain alcohols.” It appears that the Examiner may have overlooked this passage prior to rendering the instant rejection because no mention of the passage was made by the Examiner in setting forth the basis of the rejection. Based on this express disclosure of the meaning of the term in question, it is submitted that the term long chain alcohol has been given a definite meaning that renders the claim to be clear and concise. Therefore, the rejection is improper and should be removed.

### **Obviousness Rejection**

Claims 1-19 were rejected under 35 USC §103(a) as being unpatentable over Cain et al. (EP 0 901 804) (“Cain”) in view of Kimura (CAPLUS abstract, 1994:321866) (“Kimura”), Hohnen Oil CO. (CAPLUS abstract, AN 1986:18914) (“Hohen”), and Tanaka (CAOLUS abstract, AN 1989:153130) (“Tanaka”). (Paper No. 6 at 3.)

Hohnen Oil CO. (CAPLUS abstract, AN 1986:18914) ("Hohen"), and Tanaka (CAOLUS abstract, AN 1989:153130) ("Tanaka"). (Paper No. 6 at 3.)

For the reasons set forth below the rejection, respectfully is traversed.

Cain discloses a fat dispersion requiring at least one fat, a particulated sweetener, and a viscosity reducing component. (p. 2, lns 17-18.) The fat was disclosed as being cocoa butter or fractions thereof, illipe or fractions thereof, palm oil fractions, palm kernel oil or fractions thereof, polyol poly esters and saturated triglycerides with fatty acid residues with mixed chain length, in particular having 2-12 and 16-24 C-atoms. (p. 3, lns. 6-8.) The sweetener was disclosed as being selected from glucose, fructose, sucrose, maltose, lactose, sorbitol, lactitol, mannitol, maltitol, xylitol, maltodextrin and polydextrose. (p. 2, lns. 56-58.) The viscosity-reducing component was disclosed as being a long chain alcohol having from 24-34 C-atoms. (p. 2, lns. 26, 34-54.) The Examples disclose preparing various chocolate formulations. In preparing the various formulations, the chocolate was melted, liquid cocoa butter was then added, and depending on the formulation, octacosanol was added. (Example I.) Example I disclosed that, all other ingredients being equal, octacosanol lowered the viscosity at 50°C from 0.33 Pas (no octacosanol) to 0.28 Pas (0.4% octacosanol). Example II disclosed that, without the cocoa butter, 0.4% octacosanol decreased the viscosity from 0.46 Pas (no cocoa butter, no octacosanol) to 0.33 (no cocoa butter, 0.4% octacosanol) at 50°C. Example III disclosed that hardened oil fractions did not decrease the viscosity at 50°C. Example IV disclosed the effect of adding the long chain alcohol as a solid and, among other things, the addition of an emulsifier, lecithin, to the formulation. This produced viscosities of 0.2025 Pas and 0.1956 Pas at 70°C. Example IV disclosed the effect of different sources of long chain alcohols.

Kimura discloses preparing a test liquid for administering intragastrically to mice having C 22-38 aliphatic alcohols, tocopherol (I), octacosanol (II) and corn oil. (Abst.) The results demonstrated that octacosanol distributed higher in every tissue and organ than a test liquid having polyoxyethylene sorbitan monooleate instead of tocopherol and corn oil.

Hohmen discloses dissolving vitamin E, soybean lecithin, and octacosanol in vegetable oil. The dissolved solution was then encapsulated.

Tanaka discloses preparing an emulsified beverage by solubilizing octacosanol by fats and oils, water-soluble emulsifiers, and oil soluble emulsifiers, then mixing with aqueous solutions.

In making the rejection, the Examiner asserted that “Cain teaches a fat-containing product and the method of making the same.” (Paper No. 6 at 3.) The Examiner asserted that Cain’s mixture had reduced viscosity. The Examiner acknowledged, however, that Cain “does not expressly teach the employment of the particular vegetable oil or the particular food products herein, such as non-continuous oil phase products. (Paper No. 6 at 4.)

To fill the acknowledged gap, the Examiner relied upon Hohmen and Kimura as “teaching the employment of vegetable oil, such as soybean oil and corn oil for solubilization of fatty alcohols.” The Examiner also relied on Tanaka as “teaching employing oil-fatty alcohol mixture for making oil in water emulsion.).

The Examiner reasoned that:

(1) “[a] person of ordinary skill in the art would have been motivated to make an oil-long chain alcohol mixture wherein the oil is essentially free of medium chain triglyceride, or make the mixture into a non-continuous oil phase mixture because the long chain alcohol is known to reduce viscosity of oils, including those without medium chain glyceride;” (Paper No. 10 at 4);

(2) “[u]sing the alcohol-oil mixture taught by Cain to make a particular non-continuous oil phase food product is considered within the skill of the artisan, because it is known to employ oil-fatty alcohol mixture for making oil-in-water emulsion;”

(3) “optimization of the mixing procedure herein, is considered within the skill of the artisan;”

(4) “Cain’s claimed subject matter does not require any emulsifier or surfactant;”

(5) “Cain teaches the employment of long chain alcohol for reducing the viscosity of edible oil products;” and

(6) “[t]he difference claimed herein is in degree, not kind. Such variation is obvious and is well within the skill of the artisan.”

The Examiner concluded that “[I]t would have been *prima facie* obvious to a person of ordinary skill in the art, at the time the claimed invention was made, to make an oil-long chain alcohol mixture wherein the oil is essentially free of medium chain triglyceride, or make the mixture into non-continuous oil phase mixture.” (Paper No. 10 at 3.)

At the outset, a *prima facie* case of obviousness requires that the rejection describe with specificity **why** one skilled in the art would have combined two references to arrive at the claimed invention. In other words, the Examiner must provide an explanation about why one of ordinary skill in the art, looking to solve the problem faced by the inventors, would

look to the cited documents. Merely pointing to the individual claim elements in various documents coupled with broad assertions, such as, “is considered within the skill of the artisan” without more, is not enough to carry the Examiner’s burden.

In the instant case, the Examiner has not set forth reasons **why** one would look to Kimura, Hohnen, and Tanaka to close the gaps in Cain in an effort to solve the problem solved by the instant invention. “Being within the skill of the artisan” is not the requisite motivation to combine references. Therefore, the rejection is improper and should be withdrawn.

Amended independent claim 1, independent claim 12, and independent claim 17 each affirmatively required that the claimed oil/alcohol admixture have a viscosity of less than about 200 centipose (0.2 Pas) at 70°F. Cain does not disclose or suggest such a viscosity at the measured temperature. Cain took viscosity measurements at 50°C (122°F) and 70°C (158°C). The lowest viscosity measurement at 50°C (122°F) using octacosanol in Cain’s disclosure was 0.28 Pas, which is not only at a temperature over 50 degrees higher than the claimed measurement temperature, but is **also 40% greater viscosity at that higher temperature than that which is explicitly claimed**. Additionally, the Examiner provided no motivation or suggestion in the cited references that using the edible oil as required in the claimed invention would produce this result.

Further, at 70°C (158°F), which is more than twice the claimed temperature for measuring viscosity, Cain discloses viscosities of 0.2025 and 0.1956. Such numbers were achieved by Cain using not only a greater temperature for measuring viscosity, but adding, among other things, an emulsifier, which was not used to obtain the measurement at 50 °C. Therefore, it is submitted that in addition to the acknowledged gap, Cain also does not disclose or suggest any methods and compositions requiring a long chain alcohol and the specified edible oil in admixture having the affirmatively required viscosity. For this reason, the rejection is improper and should be withdrawn.

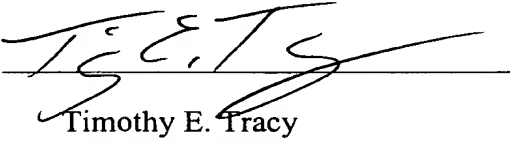
Additionally, the emulsifier in Tanaka cannot be removed when combined with Cain because Tanaka is expressly concerned with “emulsified beverages.” One of ordinary skill in the art, it is submitted, would know that such beverages affirmatively require emulsifiers. Thus, the combination of Tanaka with Cain would affirmatively require emulsifiers, which is expressly excluded from the claimed invention. Therefore, the rejection, to the extent it relies on Tanaka, is improper and should be withdrawn.

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Accordingly, for the reasons set forth above, withdrawal of the rejections and objections and allowance of the claims is respectfully requested. If the Examiner has any questions regarding this paper, please contact the undersigned.

Respectfully submitted,

By:

A handwritten signature in black ink, appearing to read 'T.E. Tracy', written over a horizontal line.

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